

IN THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 10. This sheet, which includes Fig. 10, replaces the original sheet including Fig. 10.

Attachment: Replacement Sheet

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-23 are currently pending, Claims 1-23 having been amended. The changes and additions to the claims do not add new matter and are supported by the originally filed specification, for example on page 38, line 29 to page 39, line 16, original Claim 6, and Fig. 10.

In the outstanding Office Action, the specification was objected to; Claims 1, 9, 12, 18, and 20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite; Claims 8 and 17 were objected to for informalities; and Claims 1-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gordon Lee et al. (U.S. Patent No. 6,958,992, hereafter “Gordon”) in view of Hee Lee et al. (U.S. Patent No. 6,751,459, hereafter “Hee”).

Applicant notes that the Examiner did not consider the foreign references listed in the Information Disclosure Statement (IDS) filed on April 25, 2006.

As stated in MPEP §609.04(a)(II):

“Translations are not required to be filed unless they have been reduced to writing and are actually translations of what is contained in the non-English language information. If no translation is submitted, the examiner will consider the information in view of the concise explanation and insofar as it is understood on its face, e.g., drawings, chemical formulas, English language abstracts, in the same manner that non-English language information in Office search files is considered by examiners conducting searches.”

A concise statement of the relevance of the submitted foreign references was included in the International Search Report for related International Application No. PCT/JP03/14939, filed with the current application on January 30, 2006. Accordingly, it is respectfully requested that all references listed in the IDS of April 25, 2006 be considered.

With respect to the amendment to Fig. 10, which changes reference “70u” to “21u”, Applicant respectfully submits that this change does not add new matter and is supported in the originally filed specification, for example, on page 37, lines 2-3.

With respect to the objection to the specification, Applicant respectfully traverses this ground of objection. The Office Action asserts that on page 15, line 35 of the specification, “telephone terminal 31” should refer to “telephone terminal 21” based on the drawings. However, the context of the specification reads “the telephone number of the ordinary telephone terminal 31.” Therefore, the reference 31 is referring to the telephone number of the ordinary telephone terminal and not the telephone terminal itself. Thus, Applicant submits that the specification does not need to be amended and this objection should be withdrawn.

With respect to the rejection of Claims 1, 9, 12, 18 and 20 under 35 U.S.C. §112, second paragraph, Applicant respectfully submits that the amendments to Claims 1, 9, 12, 18, and 20 overcome this ground of rejection. Also, the Examiner questioned how the network of Claim 1 is related to the other components. Applicant submits that the specification makes it clear in the example of Fig. 1 that an IP network 1 is used to connect the different components to each other. Additionally, the term “designation address,” which was questioned by the Examiner, is made clear by the Applicant’s specification, in which in a non-limiting example, the designation address may be the IP address of private base station apparatus 100u in a user’s house (see page 38, lines 34-39). Also, the term “priority registration address,” which was questioned by the Examiner, is made clear by the specification, in which in a non-limiting example a priority registration address may be an address of a forwarding destination (see page 15, line 20 to page 16, line 15).

With regards to the objection to Claims 8 and 17, Applicant respectfully submits that the amendment to Claims 8 and 17, in which the term “removably” is deleted, overcomes this ground of objection.

With respect to the rejection of Claim 1 under 35 U.S.C. §103(a), Applicant respectfully submits that the amendment to Claim 1 overcomes this ground of rejection.

Amended Claim 1 recites, *inter alia*,

a private base station apparatus configured to connect with an IP network by transmitting and receiving IP packets;

a mobile terminal device configured to connect with said IP network by wireless communication through either a public wireless base station or said private base station apparatus;

an IP telephone terminal configured to talk through said private base station apparatus with said IP network by transmitting and receiving IP packets; and

a call connection server configured to connect a call at a predetermined telephone number of said IP telephone terminal to either said IP telephone terminal or said mobile terminal device on the basis of a designation address of said IP telephone terminal which is associated with said predetermined telephone number.

Applicant’s amended Fig. 10 shows a non-limiting embodiment of the features of Claim 1. Fig. 10 shows a private base station 100u, a mobile terminal device 90u, an IP telephone terminal 21u, and a call connection server that includes elements 11-13. In this example, the call connection server can connect a call to a user at a predetermined telephone number of the IP telephone terminal 21u to either the IP telephone number 21u or the mobile terminal device 90u (via the private base station apparatus 100u) on the basis of a designation address. (See page 39, lines 2-16).

Applicant respectfully submits that Gordon and Hee fail to disclose or suggest at least these features of amended Claim 1.

Gordon is directed to a method of registering an IP phone with an IP phone switch. Fig. 1 of Gordon shows a system that includes IP phone switch 100 and IP phones 102 connected to network 104. Gordon also shows the internet 108 and PSTN 106 connected to the IP phone switch 100. However, Gordon does not disclose a system that includes a mobile terminal device, a private base station apparatus, and an IP telephone terminal. Additionally, the IP Phone Switch 100 in Gordon is configured to communicate with the IP phone 102. However, Gordon does not describe that the IP Phone Switch “is configured to connect a call at a predetermined telephone number of an IP telephone terminal to either the IP telephone terminal or a mobile terminal device on the basis of a designation address of the IP telephone terminal which is associated with the predetermined telephone number,” as defined by Claim 1. Therefore, the IP Phone Switch of Gordon cannot correspond to the claimed call connection server of Claim 1. Thus, Gordon fails to disclose or suggest at least a mobile terminal device, a private base station apparatus, or a call connection server as defined by Claim 1.

The Office Action relies on Hee to remedy the deficiencies of Gordon with regard to Claim 1.

Hee is directed to a method of updating information in a personal mobility database server with information concerning a user’s nomadicity. Fig. 1 of Hee shows a PMDNS server 150 that keeps track of where in the network a user has registered (see col. 2, lines 61-67). Hee describes a tower 130 which service communications within a respective cell for cellular network 112. The Office Action takes the position that tower 130 corresponds to the claimed private base station of Claim 1. Hee also describes wireless handset 132, which the Office Action interprets as corresponding to the claimed mobile terminal device.

However, Hee describes that “as is known, cellular network 112 includes a plurality of towers, e.g., 130, that each service communications within a respective cell.” (See col. 4,

lines 60-62 of Hee). Therefore, tower 130 is a general public base station, which is not the same as a “private base station apparatus,” which is meant to operate privately for a user.

For example, control of the path selection on a network is made easier by forwarding IP telephone and processing IP communication by connecting to a private base station apparatus. In this case, a communication system can be easily built by only installing a private base station apparatus that already connects to IP networks, such as ADSL. Additionally, it is possible to miniaturize a private base station apparatus. For example, even if a user is in a place where a radio wave from a public radio base station does not reach, then the user can connect a private base station to a PC connected to a network to build a private communication environment. Additionally, with a usual base station, one cell phone is called from a plurality of base stations which surround it. However, in the present example of the invention, a small Femto cell is used and a call can only be made from a corresponding private base station apparatus, which saves resources.

Thus, Hee fails to provide the advantages of the invention of Claim 1, in which through the use of a private base station apparatus a user can receive a call at an IP telephone terminal or a mobile terminal device, regardless of radio wave access and with an effective use of resources.

Therefore, Hee fails to disclose or suggest “a private base station apparatus configured to connect with an IP network by transmitting and receiving IP packets; a mobile terminal device configured to connect with said IP network by wireless communication through either a public wireless base station or said private base station apparatus; an IP telephone terminal configured to talk through said private base station apparatus with said IP network by transmitting and receiving IP packets,” as defined by Claim 1.

Therefore, Hee fails to remedy the deficiencies of Gordon with regard to amended Claim 1. Thus, Applicant respectfully submits that amended Claim 1 (and all associated

dependent claims) patentably distinguishes over Gordon and Lee, either alone or in proper combination.

Independent Claim 9 recites the call connection server that is part of the communication system which includes the private base station apparatus, the mobile terminal device, and the IP telephone terminal. Independent Claim 12 recites the mobile terminal device that is part of the communication system which includes the private base station apparatus, the IP telephone terminal, and the call connection server. Thus, Applicant respectfully submits that amended Claims 9 and 12 (and all associated dependent claims) patentably distinguish over Gordon and Lee, either alone or in proper combination, for the same reasons discussed above with regard to Claim 1.

Independent Claim 18 recites a method for a communication system which includes the private base station apparatus, the mobile terminal device, the IP telephone terminal, and the call connection server. The method includes step (A), in which the call connection server receives a terminal location address for identifying the location of the current private base station apparatus on said IP network with which the mobile terminal device is connected. It is clear from the above descriptions of Gordon and Lee that there is no disclosure or suggestion of such a method. Thus, Applicant respectfully submits that amended Claim 18 (and all associated dependent claims) patentably distinguishes over Gordon and Lee, either alone or in proper combination.

Consequently, in light of the above discussion and in view of the present amendment, the outstanding grounds for rejection are believed to have been overcome. The present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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